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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,663	12/04/2001	Manolito E. Adan	M61.12-0409	1564
27366	7590	02/24/2006	EXAMINER	
WESTMAN CHAMPLIN (MICROSOFT CORPORATION)			SAID, MANSOUR M	
SUITE 1400 - INTERNATIONAL CENTRE			ART UNIT	
900 SECOND AVENUE SOUTH			PAPER NUMBER	
MINNEAPOLIS, MN 55402-3319			2673	

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/004,663

Applicant(s)

ADAN ET AL.

Examiner

MANSOUR M. SAID

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-22 and 36-45 is/are pending in the application.
- 4a) Of the above claim(s) 23-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-22 and 36-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/22/02, 7/04/02; 5/16/05; 6/26/05; 1/23/06; 2/14/02; 6/16/02
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 18-22 and 36-45 in the reply filed on October 3, 2005 is acknowledged.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 18-22, 36, and 38-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Gillick et al (5,530,455; hereinafter referred to as Gillick).**

As to **claim 18**, Gillick teaches a computer system capable of executing instructions and generating images on a display (figure 7 and column 5, line 19 through column 6, line 36), a mouse (computer mouse, (figure 1, (10)) having a palm rest area (mouse (10)) & (column 3, lines 19-23) and a computer-readable medium having computer-executable instructions for performing steps comprising (figure 7 and column 5, line 19 through column 6, line 36): generating at least one of five mouse input values (control buttons, (figure 1, (18, 20, 22, 24 & 25)), each mouse input value capable of having one of only two states (column 3, lines 14-33, column 3, lines 46-67, & column 5, lines 1-26); executing an application that displays document pages in a temporally serial manner on a display (column 6, lines 20-36); identifying when a first mouse input value is in a first state and causing the application to display a previously displayed document page based in part on the first mouse input value being in the first state regardless of the position of a cursor on the display (figures 1, 5 & 7, column 5, line 19 through column 6, line 36).

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As to claim 19, Gillick teaches further computer-executable instructions for performing the step of identifying when the first mouse input value is in a second state after identifying when the first mouse input value was in the first state and wherein causing the application to display a previous document page is based on the first mouse input value being in a first state and then in a second state (figures 1, 5 & 7, column 5, line 19 through column 6, line 36).

As to claim 20, Gillick teaches wherein the first mouse input value represents the state of a switch and the first state indicates that the switch is closed (stop stroking) (column 7, lines 34 through column 8, line 6).

As to claim 21, Gillick teaches wherein the first mouse input value represents the state of a switch and the second state indicates that the switch is open (begin stroking) (column 7, lines 34 through column 8, line 6).

As to claim 22, Gillick teaches wherein each of the five mouse input values represents the state of a separate switch (figure 1, (18, 20, 22, 24 & 25)), and column 3, lines 14-33, column 3, lines 46-67, & column 5, lines 1-26).

As to claim 36, Gillick teaches a computer mouse (computer mouse, (figure 1, (10)), for use with a computer the computer running software, said mouse (column 3, lines 14-33), comprising: a housing (figure 1); and at least one user depressible surface exposed on the housing for communicating a first command signal to the computer (buttons, (figure 1, (18, 22 & 24)), (column 3, lines 14-23 & column 3, lines 55-60), the first command signal associated with a paging back function of the software (column 4, lines 59-67), whereby depression of the user depressible surface causes the software to page backward even when a displayed cursor is not positioned over a back button displayed by the software (figures 1, 5 & 7, column 4, lines 59-67,

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column 5, line 19 through column 6, line 36).

As to claim 38, Gillick teaches wherein the user depressible surface is located on a side of the housing (side button, (figures 1 & 7, (25)) and column 4, lines 6-18).

As to claim 39, Gillick teaches wherein the user depressible surfaces are located on a side of the housing (side button, (figures 1 & 7, (25)) and column 4, lines 6-18).

As to claim 40, Gillick teaches a computer mouse (computer mouse, (figure 1, (10)) including a housing, electronic circuitry located within the housing (mouse driver, (figure 7, (57)) & (column 4, lines 19-55), a mouse cursor position control arrangement coupled the electronic circuitry for allowing a user to control the mouse cursor position on a computer monitor (figures 1 & 7, column 3, lines 14-67 and column 4, lines 19-55), the electronic circuitry (mouse driver, (figure 7, (57)) in communication with devices for communicating output control signals from the electronic circuitry to a computer (figures 1 & 7, column 3, lines 14-67 and column 4, lines 19-55), a plurality of finger-depressible buttons (control buttons, (figure 1, (18, 20, 22, 24 & 25)) exposed on the housing and interfacing with switches (column 4, lines 6-57), the switches electrically coupled with the electronic circuitry for allowing user selection of output control signals communicated to the computer (figure 7 and column 4, lines 6-67), wherein: at least one of the buttons is associated with a page-back function such that depression of the least one button causes software to receive a page-back message that initiates a page-back function executed by the software (figures 1, 5 & 7, column 4, lines 59-67, column 5, line 19 through column 6, line 36); and the software receiving the page-back message without the mouse cursor being located on a back button displayed on the monitor (figures 1, 5 & 7, column 4, lines 59-67, column 5, line 19 through column 6, line 36).

As to claim 41, Gillick teaches wherein at least one of the buttons (roller, (figures 1, 4-5 & 7)) is associated with a page-forward function such that depression of the at least one button causes software to receive page-forward message that initiates page-forward function executed by the software (figures 1, 5 & 7, column 4, lines 59-67, column 5, line 19 through column 6, line 36, and column 7, lines 34 through column 8, line 6); and the software receiving the page-forward message without the mouse cursor being located on a forward button displayed on the monitor (figures 1, 5 & 7, column 4, lines 59-67, column 5, line 19 through column 6, line 36).

As to claim 42, Gillick teaches a method of using a computer mouse (computer mouse, (figure 1, (10))), the mouse having cursor position control arrangement for controlling cursor position on display, and user-activatable buttons (column 3, lines 14-67), wherein the method comprises: activating one of the buttons to send a page-back signal to software, regardless of the cursor position on the display, for execution of page-back function (figures 1, 5 & 7, column 4, lines 59-67, column 5, line 19 through column 6, line 36).

As to claim 43, wherein the method further comprises activating one of the buttons to send a page-forward signal to software, regardless of the cursor position on the display, for execution of a page-forward function (figures 1, 5 & 7, column 4, lines 59-67, column 5, line 19 through column 6, line 36).

As to claim 44, a method of operating software using a computer mouse (computer mouse, (figure 1, (10))), the mouse having a cursor position control arrangement for controlling a cursor position on display (column 3, lines 14-67), and user activatable buttons (buttons, (figure 1 & 7, (18, 20, 22, & 24-25)) & (column 4, lines 5-19), wherein the method comprises: depressing at least one of the buttons to send a page-back signal software for execution of a

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page-back function regardless of the cursor position on the display (figures 1, 5 & 7, column 4, lines 59-67, column 5, line 19 through column 6, line 36).

As to **claim 45**, further comprising: depressing at least one of the buttons (roller, (figures 1, 5 & 7, (24)) to send a page-forward signal to software for execution of a page-forward function regardless of the cursor position on the display (figures 1, 5 & 7, column 3, lines 55-67, column 4, lines 59-67, column 5, line 19 through column 6, line 36, and column 7, line 34 through column 8, line 6).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gillick in view of Grant (5,854,624).

Gillick teaches all claimed limitations in claim 37 except that a second user depressible surface for communicating with a paging forward function of the software.

However, Grant teaches an input device (figure 1, (30)) including buttons and pointer (column 4, lines 20-40), and also two buttons (PG UP/PG DN) have a specific functionality, such as, providing for quick traversing through a multi-pages on-screen document, one page at a time (column 5, lines 1-67).

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Grant's input device having PG UP/PG DN buttons into Gillick's device so as to provide for quick traversing through a multi-paged on-screen document, one page at a time (column 5, lines 15-20).

Conclusion

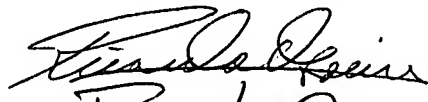
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MANSOUR M. SAID whose telephone number is (571) 272-7679. The examiner can normally be reached on MF (8:30-6:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BIPIN SHALWALA can be reached on (571) 272-7681. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mansour M. Said

2/14/06


Ricardo Osorio
PRIMARY EXAMINER